

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
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Arlington, Virginia 22202-3513

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Opposition No. 110,741

Regal Ware, Inc.

v.

Tiger Corporation

Before Seeherman, Chapman, and Bucher,
Administrative Trademark Judges

By the Board:

Tiger Corporation ("applicant") seeks to register the mark SAHARA for "vacuum bottles, thermal containers for boiled rice, and thermal pots and pans for cooking."¹

Registration has been opposed by Regal Ware, Inc. ("opposer"). As grounds for opposition, opposer alleges, in relevant part, that applicant's mark is laudatory, and therefore descriptive, as applied to the identified goods; that SAHARA is a common geographic term; that applicant's goods are manufactured in Osaka, Japan, and that, as a

¹ Application Serial No. 75/142,147, filed on June 30, 1996, alleging October, 1986 as the date of first use and May, 1990 as the date of first use of the mark in commerce.

result, applicant's mark is primarily geographically misdescriptive of the identified goods; that from January 16, 1978 to 1990, opposer engaged in the manufacture, distribution and sale in interstate commerce of goods including cooking utensils, sauce pans, Dutch ovens, fry pans, skillets, tea kettles, double boilers, griddles, and casseroles under the mark SAHARA; that opposer has a valid and legal right to use the term SAHARA to describe its goods; that registration of SAHARA by applicant will impair opposer's right to the descriptive use thereof; and that the parties' use of identical marks on goods that include pots and pans for cooking is likely to cause confusion among consumers resulting in warranty claims and product liability claims against opposer.

In lieu of an answer, applicant filed a combined motion to dismiss the proceeding under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted as to opposer's claim under Trademark Act Section 2(d), and for summary judgment as to opposer's claims under Trademark Act Sections 2(e)(1) and 2(e)(3).

In support of its Rule 12(b)(6) motion, applicant essentially argues that, prior to publication, the application at issue was refused registration under Trademark Act Section 2(d) in view of Registration No. 1,120,546, owned by opposer herein, for the mark SAHARA;

that applicant filed a petition for cancellation of opposer's registration (Cancellation No. 25,772) in which default judgment was entered against respondent (opposer herein); that by order dated January 20, 1998, the Commissioner cancelled Registration No. 1,120,546; that opposer possesses no current rights in the mark SAHARA; that the Board entered judgment against opposer in Cancellation No. 25,772 and held that opposer abandoned any rights it may have had in its SAHARA registration; that opposer has not alleged any current rights superior to that of applicant in the SAHARA mark; that opposer is estopped from so asserting in view of the Board's judgment in Cancellation No. 25,772; and that, as a result, opposer has not asserted a proper ground for opposition under Section 2(d).²

In support of its motion for summary judgment, applicant essentially argues that the term SAHARA has no descriptive significance as applied to the goods identified in the application at issue; that the term SAHARA does not

² We note that while applicant has submitted matters outside the pleadings as attachments 1-4 in support of its motion to dismiss, said attachments are excluded and will be given no consideration in our determination thereof. Accordingly, we are treating applicant's motion to dismiss as one brought under Fed. R. Civ. P. 12(b)(6) on the legal sufficiency of opposer's claim under Trademark Act Section 2(d). See, for example, Fed. R. Civ. P. 12(b); *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); and *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983).

denote a specific geographic location but rather signifies a desert covering a vast portion of North Africa; that the SAHARA region is devoid of commercial activity, particularly with respect to manufacture of consumer products; that no association exists in the minds of consumers between SAHARA and applicant's goods; and that, as a matter of law, SAHARA is neither merely descriptive nor geographically deceptively misdescriptive of applicant's goods.

To support its position, applicant has submitted the file history of opposer's cancelled Registration No. 1,120,546; a dictionary definition of the term SAHARA; copies of the results of searches of various printed and electronic resources conducted on behalf of applicant in regard to the term SAHARA; and the affidavit of Mary M. Dale, one of applicant's attorneys.

Opposer filed a combined brief in response, essentially arguing that applicant's motion cannot be considered a motion for summary judgment because opposer has not been afforded an opportunity to conduct discovery; that opposer will not address the evidence submitted by applicant in support of its motion as such evidence is outside of the pleadings; that in the event the Board considers said evidence, the Board must first notify the parties that it is converting the motion under consideration into a motion for summary judgment; and that, as a result, opposer is treating

applicant's motion only as one brought under Fed. R. Civ. P. 12(b)(6). Opposer argues moreover that it has properly pleaded that the term SAHARA is laudatory and thus descriptive; that it has properly pleaded that the term SAHARA is geographically deceptively misdescriptive; that from January 1978 to 1990, opposer used the mark SAHARA to identify various goods used for cooking; that opposer has not used the mark SAHARA since 1990; and that if applicant provides assurances to opposer that applicant "will not attempt to pass for a successor of the Opposer", opposer will withdraw its pleaded claim in regard to its use of the mark SAHARA.

Applicant filed a brief in reply³, arguing that opposer has conceded it has not used the mark SAHARA since 1990; that opposer's registration for the mark SAHARA was cancelled on the ground of abandonment; and that, accordingly, opposer's claim under Section 2(d) cannot be maintained. Applicant further argues that opposer has not responded to applicant's motion for summary judgment as to opposer's claims under Sections 2(e)(1) and 2(e)(3); that Fed. R. Civ. P. 56(f) provides for discovery if opposer believes it is necessary in order to respond to the motion for summary judgment; that opposer has made no such motion

³ Consideration of reply briefs is discretionary on the part of the Board. See Trademark Rule 2.127(a). In this case, the Board

for 56(f) discovery; and that applicant's motion for summary judgment is properly brought.

Applicant's Motion to Dismiss Opposer's Section 2(d) Claim Under Rule 12(b)(6) Granted

In order to withstand a motion to dismiss under Rule 12(b)(6), a pleading need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

We note initially that applicant does not question opposer's standing to maintain this opposition proceeding. The pleading clearly includes allegations sufficient for standing.

In order to properly state a claim of likelihood of confusion, opposer must plead (and later prove) that (1) applicant's mark, as applied to its goods or services, so resembles opposer's mark or trade name as to be likely to cause confusion, mistake, or deception; and (2) priority of use. *See Fed. R. Civ. P. 8; King Candy Co., Inc. v. Eunice*

has considered applicant's reply brief because it assists in clarifying the issues under consideration.

King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

After a careful review of the pleadings, we note that opposer has sufficiently pleaded that applicant's mark, as applied to its goods, so resembles that of opposer as to cause confusion, mistake or deception. However, opposer alleges use of the mark SAHARA only from 1978 to 1990 (the notice of opposition was filed on June 5, 1998), and in response to the motion to dismiss, has confirmed that it has not used the mark since 1990. Thus, on its face the pleading shows that opposer has abandoned any trademark rights it may have had in SAHARA. Accordingly, opposer is unable to prove one of the necessary elements for a valid claim upon which relief can be granted under Section 2(d) of the Trademark Act.

In view thereof, applicant's motion to dismiss is granted. Opposer's claim under Section 2(d) is stricken from the notice of opposition.

Applicant's Motion for Summary Judgment as to Opposer's Section 2(e)(1) and 2(e)(3) Claims Granted

We note initially that opposer arbitrarily treated applicant's motion for summary judgment as a motion to dismiss under Rule 12(b)(6). When a motion for summary judgment is made and supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to

judgment, the non-moving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. See Fed. R. Civ. P. 56(e). See also *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Accordingly, opposer may not avoid summary judgment by refusing to respond to applicant's properly raised motion therefor.

Moreover, opposer's assertion that summary judgment is inappropriate in this case because opposer was not afforded an opportunity to conduct discovery is not well taken. If a party believes that it cannot effectively oppose a motion for summary judgment without first taking discovery, the appropriate response is for the responding party to file a request supported by an affidavit showing that it cannot, for reasons stated, present by affidavit facts essential to justify its opposition to the motion. See Fed. R. Civ. P. 56(f). See also *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989) (wherein the Court stated "Prescience is not a required characteristic of the Board,"

and "A party may not simply assert that discovery is necessary and thereby overturn summary judgment when it fails to comply with the requirement of Rule 56(f) to set out reasons for the need for discovery in an affidavit.") Opposer filed no such motion under Rule 56(f) in this case.

As has often been stated, summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine, if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's*

Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA*, *supra*.

After a careful review of the record in this case, we find that there are no genuine issues of material fact and that applicant is entitled to judgment as a matter of law.

Applicant's evidence includes a dictionary definition of the term SAHARA, defined under geographic entries as a "[v]ast desert of N Africa, extending from the Atlantic coast to the Nile valley and from the Atlas Mts. S to the Sudan." *The American Heritage Dictionary*, 1518 (1982).

(Exhibit 6 to applicant's main brief on motion for summary judgment.) We note in addition that SAHARA is defined in *Webster's Third New International Dictionary*, (1993) as "something regarded as arid, barren, or deserted."⁴

Applicant's evidence also includes an entry from *The Universal Almanac* (1995) indicating that the term SAHARA means "wilderness" in the Arabic language; a printed copy of the results of a computer network search of *The World Factbook* (1997) indicating that the territory known as "Western Sahara" depends on pastoral nomadism, fishing, and phosphate mining as principal sources of income for its sparse population; a printed copy of the results of searches of the Lexis/Nexis computer database demonstrating that the

⁴ The Board may take judicial notice of dictionary definitions. See, for example, *University of Notre Dame du Lac v. J. C.*

term SAHARA lacks laudatory or otherwise descriptive significance as applied to applicant's goods; an entry from *The World Book Encyclopedia* (1995) indicating that the area identified by the term SAHARA is the world's largest desert, the inhabitants of which rely on nomadic herding and farming for subsistence; an entry from the *World Business Directory* (1998) that lacks a listing for the term SAHARA; and an entry from the *Encyclopedia of Global Industries* (1996) that similarly lacks a listing for the term SAHARA.

We note that opposer has proffered no evidence in rebuttal to that submitted by applicant.

The evidence shows there is no genuine issue that SAHARA identifies only a desert region, essentially devoid of commercial activity, covering portions of several countries in North Africa. A geographic name is not unprotectible or unregistrable merely because it can be labeled a geographic name, but because it tells the public something about either the product or the producer about which its competitor also has a right to inform the public. Thus, the names of places devoid of commercial activity are arbitrary usage, and therefore registrable. See *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (CCPA 1982); and *In re Charles S. Loeb Pipes, Inc.* 190 USPQ 238 (TTAB 1976). Because there is no genuine issue that the purchasing public

Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), *aff'd*,

would not make a goods/place association between applicant's goods and the SAHARA region, applicant has established, as a matter of law, that its mark is not primarily geographically deceptively misdescriptive. Further, the evidence shows there is no genuine issue that SAHARA has no laudatory or descriptive meaning for the goods identified in applicant's application. Accordingly, as a matter of law, applicant has established that the term SAHARA is not laudatory or merely descriptive of its goods.

In view thereof, applicant's motion for summary judgment is granted.

In summary, applicant's motion to dismiss under Fed. R. Civ. P. 12(b)(6) is granted on the issue of likelihood of confusion; and applicant's motion for summary judgment under Fed. R. Civ. P. 56 is granted on the issues of descriptiveness and geographic deceptive misdescriptiveness. Judgment is hereby entered against opposer, and the opposition is dismissed.

E. J. Seeherman

B. A. Chapman

D. E. Bucher
Administrative Trademark Judges
Trademark Trial and Appeal Board